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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/856,387	05/22/2001	Richard McEwan	604.35-US1	8008
35856	7590	10/12/2004	EXAMINER	
LAVA GROUP LAW BY SMITH & FROHWEIN, LLC P.O. BOX 88148 ATLANTA, GA 30356			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/856,387	MCEWAN ET AL.	
Examiner	Art Unit	3621	<i>Mu</i>
Mary Cheung			

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 June 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Status of the Claims

1. This action is in response to the amendment filed on June 29, 2004. Claims 1-20 are pending. Claim 1 is amended. Claim 20 is added.

Response to Arguments

2. Applicant's arguments filed June 29, 2004 have been fully considered but they are not persuasive.

Applicant argues that Alberts (U. S. Patent 5,937,392) fails to teach selecting a recipient based on prospect information. Examiner believes that this limitation is an optional feature because the applicant clearly states "the marketing agent taking an active role of in at least one of...". Albert may not disclose this particular feature, but Albert discloses other features of the "at least one of..."; thus, Albert's teaching satisfied the claimed language.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the manager retains ultimate control of all the marketing agents while each marketing agent may have its own unique set of limitations as defined by the manager via the restriction function) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the newly added claim 20, examiner has added it to the office action.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6-9, 11-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts, U. S. Patent 5,937,392 in view of Angles et al., U. S. Patent 5,933,811.

As to claim 1, Alberts teaches a method of conducting an advertising campaign, comprising (abstract):

a) Providing a multi-tiered marketing environment wherein the marketing environment comprises a human marketing agent (*item 14 in Fig. 1*) and a manager (*item 16 in Fig. 1*) cooperating on the advertising campaign (column 3 lines 58-60 and Fig. 1; specifically, “*a multi-tiered marketing environment*”

corresponds to the Advertising Server Central Controller and the AD Servers marketing environment in Alberts' teaching);

- b) Providing the marketing agent with a set of advertising messages (column 3 lines 29-60 and Figs. 2-3);
- c) The marketing agent taking an active role in selecting a message from the set of advertising messages; and electronically sending the message to the recipient (column 3 lines 22-25 and column 4 lines 33-54 and Figs. 1-4);
- d) The recipient electronically responding to the message (column 4 lines 25-27);
- e) Tracking the recipient electronically responding to the message (column 4 lines 11-27);
- f) The manager retaining at least some control over the set of advertising messages provided to the marketing agent; and an authorized number of sends allocated to the marketing agent (column 3 lines 28-60).

Alberts does not explicitly teach providing the marketing agent with a set of prospect information. However, this matter is taught by Angles as providing the registration module with consumer profile information (column 3 lines 18-23, 54-61 and column 17 lines 3-10, 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the marketing agent in Alberts' teaching to be provided with a set of prospect information so that the advertisements can be more efficiently targeted to recipients.

As to claim 2, Alberts teaches the multi-tiered *marketing* environment includes at least two tiers (Fig. 1; *specifically, one tier corresponds to Advertising Server Central Controller, and the other tier corresponds to AD Servers in Alberts' teaching*).

As to claim 3, Alberts teaches the multi-tiered marketing environment includes at least two different companies (Fig. 1; *specifically, different companies corresponds to the plurality of the AD Servers in Fig. 1*).

As to claim 4, Alberts modified by Angles teaches a set of prospect information as discussed above. Alberts does not explicitly teach the set of prospect information comprises a plurality of data items stored in a prospects database. However, this matter is taught by Angles as providing the registration module with consumer profile information, and the consumer profile information comprises a plurality of data items stored in a registration database (column 3 lines 18-23, 54-61 and column 17 lines 3-10, 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the marketing agent in Alberts' teaching to be provided with a set of prospect information, and the set of prospect information comprises a plurality of data items stored in a prospects database so that the advertisements can be more efficiently targeted to recipients.

As to claim 6, Alberts teaches the set of advertising messages includes a rich media electronic advertisement (column 1 lines 9-16 and column 2 lines 62-65).

As to claim 7, Alberts teaches the set of advertising messages includes an executable a rich media electronic advertisement (column 1 lines 9-16 and column 2 lines 62-65 and column 4 lines 25-27).

As to claim 8, Alberts teaches the marketing agent selecting an advertising message and sending it to a recipient as discussed above. Alberts does not specifically teach the marketing agent selecting the recipient as part of a group of recipients. However, this matter is taught by Angles as the advertising module selecting the recipient as part of a group of recipients (column 15 lines 20-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the marketing agent in Alberts' teaching to select the recipient as part of a group of recipients so that the advertisements can be more efficiently targeted to recipients.

As to claim 9, Alberts teaches the marketing agent selecting a plurality of messages for co-transmission to the recipient (column 3 lines 22-28).

As to claim 11, Alberts teaches the step of the recipient electronically responding to the message includes the recipient opening the message using a computer (column 1 lines 12-16 and column 4 lines 25-27).

As to claim 12, Alberts teaches the step of the recipient electronically responding to the message includes the message having multiple pages, and the recipient navigating between at least two of the multiple pages (column 1 lines 9-20 and column 2 lines 62-65 and column 4 lines 25-27; specifically, *"the message having multiple pages" is interpreted as the message having HTML links which will direct the recipient to different information pages, and the recipient navigates information pages by clicking on the links*).

As to claim 13, Alberts teaches the step of tracking the response includes the recipient displaying the message sing a computer, and the computer sending an item of tracking information to a track system (column 4 lines 4-33).

As to claim 14, Alberts teaches wherein the step of providing the marked agent with a piece of information relating to the respond includes displaying to the marketing agent a piece of information relating to a hyperlink contained in the message and utilized by the recipient (column 2 lines 62-65 and column 4 lines 4-27).

As to claim 15, Alberts teaches the manager considering a percentage of responses received by the marketing agent relative to a number of sends initiated by the marketing agent (column 4 lines 4-27).

As to claim 20, Alberts teaches conducting an advertising campaign through a graphical user interface (column 2 lines 55-67 and Fig. 1). Albert does not specifically teach selection of recipients from the set of prospect information is performed through a graphical user interface. However, Angles teaches this matter (column 15 lines 20-42). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Alberts' teaching to use the graphical user interface for selecting a recipient from the set of prospect information as taught by Angles so that the advertisements can be more efficiently targeted to recipients.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts, U. S. Patent 5,937,392 in view of Angles et al., U. S. Patent 5,933,811 in further view of Boe et al., U. S. Patent 6,236,975.

As to claim 5, Alberts modified by Angles teaches a set of advertising messages as discussed above. Alberts modified by Angles does not explicitly teach the set of advertising messages includes an advertising logo. However, this matter is taught by Boe as the customer is provided with targeted customized information including logos (column 6 lines 9-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the set of advertising messages in the teaching of Alberts modified by Angles to include an advertising logo for better attract the advertisement recipients to review the advertising messages.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts, U. S. Patent 5,937,392 in view of Angles et al., U. S. Patent 5,933,811 in further view of Marsh et al., U. S. Patent 5,848,397.

As to claim 10, Alberts modified by Angles teaches the marketing agent electronically sending the message to the recipient as discussed above. Alberts modified by Angles does not explicitly teach the marketing agent initiating the sending of message using an e-mail interface. However, this matter is taught by Marsh as distributing advertising messages using an e-mail interface (column 2 line 65 – column 4 line 44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the message in the teaching of Alberts modified by Angles to be sent by using an e-mail interface because this would allow the marketing agent to send the message faster and economically.

8. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alberts, U. S. Patent 5,937,392 in view of Angles et al., U. S. Patent 5,933,811 in further view of Capek, U. S. Patent 6,026,369.

As to claim 16, Alberts further teaches:

- a) Providing a second marketing agent with a second set of advertising messages (column 3 lines 29-60 and Figs. 1-3; *specifically, "a second marketing agent" corresponds to one of the plurality of AD Server as shown in Fig. 1*);
- b) The second marketing agent taking an active role in selecting a second message from the second set of advertising messages; and electronically sending the message to the second recipient (column 3 lines 22-25 and column 4 lines 33-54 and Figs. 1-4);
- c) The second recipient electronically responding to the second message (column 4 lines 25-27);
- d) Tracking the second recipient electronically responding to the second message (column 4 lines 11-27).

Alberts does not explicitly teach providing the second marketing agent with a second set of prospect information. However, this matter is taught by Angles as providing the registration module with consumer profile information (column 3 lines 18-23, 54-61 and column 17 lines 3-10, 18-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the second marketing agent in Alberts' teaching to be provided with a second set of prospect information so that the advertisements can be more efficiently targeted to recipients.

Alberts modified by Angles does not specifically teach the second marketing agent distinct from the first marketing agent. However, this matter is taught by Capek as pluralities of the marketing agents (*access provider AP-1, AP-2, AP-3, AP-4 in Fig. 1*) are distinct from each other (column 3 lines 17-48 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the second marketing agent in the teaching of Alberts modified by Angles to be distinct from the first marketing agent as taught by Capek because this would allow the advertisements to be more efficiently distributed between the two marketing agents so that the advertisements can be better targeted to the recipients.

As to claim 17, Alberts teaches the manager exercising at least some control over the message provided to the marketing agent, and Albert modified by Angles teaches providing the marketing agent with a set of prospect information as discussed in claims 1 and 16 above. Alberts does not specifically teach the manager exercising at least some control over the set of prospect information provided to the marketing agent. However, this matter is taught by Angles as the advertisement provider exercising at least some control over the set of prospect information to the marketing agent (column 18 line 61 – column 19 line 11 and Fig. 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the manager in Alberts' teaching to have at least some control over the set of prospect information so that the advertisements can be better targeted to the recipients based on the set of prospect information.

Alberts modified by Angles does not specifically teach the manager exercising at least some control over a relationship between the set of prospect information provided to the marketing agent and the second marketing agent. However, this matter is taught by Capek as the control distribution node has control over a relationship among the information provided to the plurality of the access providers (column 3 line 15 – column 4 line 7 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the manager in the teaching of Alberts modified by Angles to include the feature of having control over a relationship among the information provided to the different marketing agents because this would allow the advertisements to be more efficiently distributed among different marketing agents so that the advertisements can be better targeted to the recipients.

As to claim 18, Alberts teaches the manager exercising some control over the set of advertising messages provided to the marketing agent as discussed in claim 1 above. Alberts further teaches the manager exercising some control over the second set of advertising messages provided to the second marketing agent (column 3 lines 28-60 and Fig. 1; *specifically, “the second marketing agent” corresponds to one of the plurality of the AD Servers in Fig. 1*). Alberts does not specifically teach the manager exercising at least some control over a relationship between the set of advertising messages provided to the marketing agent and the second set of advertising messages provided to the second marketing agent. However, this matter is taught by Capek as the control distribution node has control over a relationship among the information provided to the plurality of the access providers (column 3 line 15 – column 4 line 7 and Fig. 1). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the manager in the teaching of Alberts modified by Angles to include the feature of having control over a relationship among the information provided to the different marketing agents because this would allow the advertisements to be more efficiently distributed among different marketing agents so that the advertisements can be better targeted to the recipients.

As to claim 19, Alberts teaches the manager exercising some control over the authorized number of sends allocated to the marketing agent as discussed in claim 1 above. Alberts further teaches the manager exercising some control over an authorized number of sends allocated to the second marketing agent (column 3 lines 28-60 and Fig. 1; specifically, *“the second marketing agent” corresponds to one of the plurality of the AD Servers in Fig. 1*). Alberts does not specifically teach the manager exercising at least some control over a relationship between the authorized number of sends allocated to the marketing agent and an authorized number of sends allocated to the second marketing agent. However, this matter is taught by Capek as the control distribution node has control over a relationship among the information provided to the plurality of the access providers (column 3 line 15 – column 4 line 7 and Fig. 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the manager in the teaching of Alberts modified by Angles to include the feature of having control over a relationship among the information provided to the different marketing agents because this would allow the advertisements to be more

efficiently distributed among different marketing agents so that the advertisements can be better targeted to the recipients.

Conclusion

9. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung
Patent Examiner
Art Unit 3621
October 4, 2004



Handwritten signature of James P. Trammell, which is a stylized, cursive line. Below the signature, there is a printed name and title.

JAMES P. TRAMMELL
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